
In the
United States Court of Appeals
For the Ninth Circuit

No. 15433

CONTAINER CORPORATION OF
AMERICA,
Plaintiff-Appellant,
vs.
MCS CORPORATION,
Defendant-Appellee.

Appeal from the United
States District Court for
the Southern District of
California, Central Divi-
sion.

Honorable
Ernest A. Tolin,
Judge.

BRIEF FOR APPELLANT.

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BRIEF FOR APPELLANT.

This is an appeal by plaintiff from Judgment of the Dis-
trict Court holding plaintiff's patent in suit invalid, dis-
missing its Complaint, and sustaining a Counterclaim by
defendant, with costs to defendant.

STATEMENT OF PLEADINGS AND FACTS RE
JURISDICTION.

The Complaint in this case, filed February 25, 1954, is for infringement of plaintiff's United States Letters Patent No. 2,638,261, issued to it May 12, 1953, as assignee of William J. Poole (Tr.* 3-4, Pl. Ex.** 3), under Title 35, United States Code, and the District Court had original jurisdiction under Title 28, United States Code, Sec. 1338.

Defendant is a California corporation (Pl. Ex. 2, Tr. 41) with its place of business at 1120 North La Brea Avenue, Los Angeles, California, there conducting the business complained of under adopted names "Ree-Seal" and "Ree Seal Company" (Tr. 18, 43-44, Pl. Ex. 10, 11, 12). The United States District Court, Southern District of California, Central Division has jurisdiction of defendant under Title 28, United States Code, Section 1400 (b).

Jurisdiction, in both respects above, is admitted by defendant's Answer (Tr. 5).

The said Counterclaim by defendant (Tr. 11-12, 13) merely puts its Answer in the form of prayer for affirmative relief; it raises no further issue. It is alleged to arise under Section 2201 of Title 28 of the United States Code (Tr. 12), but plaintiff, in its Reply to Counterclaim, "denies any need for the said counterclaim because the issues presented by it are already joined by the Complaint and Answer" (Tr. 14).

This Court of Appeals has jurisdiction to review the judgment referred to, under 28, United States Code, 1291.

* Printed Transcript of Record.

** Plaintiff's Exhibit.

STATEMENT OF THE CASE.

We divide this portion of this brief into sub-headed sections, concluding with statements of the question involved and the manner in which it is raised.

In General.

Plaintiff is a Delaware Corporation (Pl. Ex. 1, Tr. 41) having its general office in Chicago, and its business is the manufacture and sale of numerous types of paperboard containers for various specific purposes (Tr. 49 *et seq.*).

The subject matter of the patent in suit is a "Frozen Food Carton with Plastic Lid", the application for the patent having been filed in the Patent Office on May 10, 1948 (Pl. Ex. 5). The development of the patented package, and the manufacture and sale of such packages by plaintiff, will be set forth presently.

Plaintiff's cause of action lies in defendant's manufacture (or causing to be manufactured) and sale of lids like plaintiff's, for use with the lower portions of used conventional waxed paper-board milk containers which the housewife would ordinarily discard.

Defendant began manufacture and sale of such bids in March of 1951 (Tr. 23), but they did not come to the attention of plaintiff until shortly before November 2, 1953, when plaintiff sent a letter to Ree-Seal (Pl. Ex. 13, Tr. 45) giving notice of infringement of the patent in suit, said letter having been received by defendant on or about November 5, 1953 (Tr. 18, 43-44).

The Proceedings Below.

As previously stated, the Complaint was filed in February, 1954, followed by defendant's Answer and Counterclaim (Tr. 5-13) and plaintiff's Reply to Counterclaim (Tr. 14-15) in April.

In June of 1954, defendant moved for summary judgment, alleging invalidity of the patent for lack of invention and lack of invention over the prior art.* That proceeding was briefed, heard, taken under advisement, and the motion denied on September 27, 1954.

In due course the case was set for trial.

In October 1955, under Title 35, United States Code, Sec. 282, defendant gave notice of seven patents upon which it would rely at the trial; also, that it would rely on testimony of William J. Poole (inventor, patent in suit) (Tr. 15-16).

On March 28, 1956, plaintiff served and filed certain Requests for Admissions of Fact (Pl. Ex. 7, Tr. 16-19, 43) and certain Interrogatories (Pl. Ex. 14, Tr. 19-21, 45) under Rules 36 and 33, respectively, of the Federal Rules of Civil Procedure. The Requests for Admissions of Fact were not answered by defendant, leaving it, under the Rule, that the facts stated stand admitted (Tr. 43-44); defendant's answers to the interrogatories are in evidence as Plaintiff's Exhibit 15 (Tr. 22-24, 46).

Memoranda prior to trial were duly filed by the parties, and trial was had May 3-4, 1956 (Tr. 39-192). Subsequent to trial, defendant submitted its Exhibits H and I, proffered during trial (Tr. 25-26).

Times were set for briefs, and briefs were filed, Brief

* We assume that it is not inappropriate for us to mention this, though not part of the printed Transcript of Record on Appeal; it is in the original Transcript of Record on Appeal, listed by the Clerk (Tr. 37-39), and we mention it so as not to fail to do so.

for Plaintiff, Closing Brief for Defendant, and Reply Brief for Plaintiff. Oral Argument was on November 5, 1956.

On November 7, 1956, the Court below handed down its Notice of Decision, finding the subject matter of the patent in suit "wanting in invention" (Tr. 26-28). This was followed by Findings of Fact, Conclusions of Law, and Judgment entered November 20, 1956 (Tr. 28-31), the Judgment, as stated above, holding the patent in suit invalid, dismissing the Complaint, and sustaining defendant's Counterclaim, with costs to defendant (Tr. 30-31).

Plaintiff filed its Notice of Appeal December 17, 1956 (Tr. 31); and its Statement of Points January 2, 1957.

The Invention, the Patent Application, and the Patent.

What follows under this and the next sub-heading is an abstract of the facts, from the Transcript of Record and the exhibits.

In early 1947, the inventor, Mr. Poole (Tr. 66) thought to provide a new and improved package in which to freeze and cold-store foods, prepared foods such as fruits and vegetables, and particularly foods which are packed by the housewife and frozen and stored either in her own deep freezer or cold compartment of her kitchen refrigerator, or at a so-called locker plant (Tr. 56 *et seq.*).

He was originally employed by the plaintiff corporation on May 1, 1940, started with a production training course there, and was shortly assigned to its package development laboratory on experimental work on frozen food packages; there he remained until April 1, 1942, when he left to enter the Marine Corps, and he returned to the company in November, 1945, to take charge of sales and development in its frozen food package department or division on January 1, 1946 (Tr. 46-49).

He was consequently familiar with the practical art, with

the frozen-food packages that the market offered, of both plaintiff and its competitors, with freezers and locker plants, and with the growing practice domestically of preparing and packaging foods for freezing (Tr. 49-55).

This, when, in early 1947, he essayed a new and improved package for the purpose, as above stated.

At that time, plaintiff was manufacturing and selling the type of frozen food container referred to by Mr. Poole on Pages 49, 50-52 of the Transcript, a rectangular paper-board container comprising four sides, a bottom, and a top with a circular opening in it, this opening being closed by a round metal plug inserted therein. Mr. Poole's description of that antecedent container was facilitated by reference to a metal can (Pl. Ex. 15-A) (Tr. 50-52, 54).

Mr. Poole's first step was to determine upon a full-open-top rectangular container body, made from a single paper-board blank cut to shape and scored for folding and glued to completion, exemplified by Plaintiff's Exhibit 16, which was "one of the initial experimental packages that was made in early 1947" (Tr. 57-59). The purpose of the "full open top" was to facilitate the filling of the carton, and, more important, the removal of the contents (Tr. 56-58), and other advantages thereof will be noted as we go along.

There was nothing new about this container body, *per se*, but the selection of this type is significant.

Then came the question of the lid, and firstly that of the material of which it was to be made. Experiments were made with paper-board, drawn or stamped metal, and molded materials such as plastic (Tr. 58). Paper-board, drawn or stamped sheet metal, and molded metal were discarded, and a polystyrene plastic, molded under heat and pressure was determined upon; this, because it could be molded to form, and for reasons of its stability through the temperature range in which it would be used, its transparency and its cost (Tr. 58-60).

The Crown Cork Specialty Corporation, of Decatur, Illinois, had been making the stamped metal closure plugs for the above-mentioned then-current Container frozen food cartons, and the matter of manufacture of the proposed plastic lids was taken up with Crown Cork's Chicago representative; and carton bodies like Plaintiff's Exhibit 16, and ideas and sketches as to how the lid should be made, were submitted to him, this still early in 1947 (Tr. 60-61).

The upshot of that was that Crown Cork's Chicago representative and Mr. Poole made a trip to Crown Cork at Decatur "to lay this problem before their engineering and production people," and they submitted "these samples and sketches to the people who would have to build the molds and live with the production problems involved" (Tr. 61).

Pursuant to understanding arrived at, Container received initial lid samples, in June of 1947 according to Mr. Poole's recollection, and placed an order for 3000 the following month (Tr. 62). These were made in a single-cavity sample-run mold (Tr. 64-65).

These 3000 lids were to go along with a like number of cartons such as Plaintiff's Exhibit 16, for distribution to selected locker plants for field test to ascertain consumer reaction (Tr. 62). According to the best of Mr. Poole's knowledge, this distribution began in August of 1947 (Tr. 62).

Mr. Poole testified (Tr. 63) that, naturally, upon receiving the lids at Container, they were inspected and checked, only to find a flaw in that "there had been no allowance made for the double thickness of board at the manufacturer's joint of the carton," *i. e.*, the "glue flap on one panel of the carton, which is glued down to the corresponding meeting panel at the other end of the blank,"—called "manufacturer's joint" because it is a joint necessarily there in the process of manufacture.

Mr. Poole stated (Tr. 63) that by using the lid in the manner that the ultimate consumer would use it, by placing it on the carton body and pressing it down, the closure would not be liquid-tight and, if enough pressure were exerted, the plastic would split or crack there.

He countered that by re-fashioning the lid to augment the recess width at that point, and consulted the Crown Cork Chicago representative to learn if the mold could be revised accordingly, and, upon report that that was feasible, a "production" mold, so revised was ordered (Tr. 64-65). A "production" mold is one with a plurality of cavities (Tr. 65).

That mold, to the best of Mr. Poole's knowledge, was ordered in September of 1947, and lids to be made from that mold were ordered in October or November of that year. One hundred thousand such lids were ordered and that number of complementary cartons were put into production at the Container plant at the same time (Tr. 65-66).

One hundred thousand was not regarded as a large number. As stated by Mr. Poole, the idea was to sell approximately 2000 units to each of fifty selected distributors, and "to use this as a complete field test, which was designed to either prove or disprove the merit of the package." These sales were in the early spring of 1948. The lid, Plaintiff's Exhibit 17, is one of the first samples off the production mold; Plaintiff's Exhibit 18 is the same as Plaintiff's Exhibit 17 with "patent-applied-for" marking added; these lids carried the arrow for indicating the position of the widened portion of the peripheral groove, for accommodating the manufacturer's joint of the carton (Tr. 66-69).

On May 10, 1948, the Poole patent application was filed, exactly illustrating and describing these cartons and lids. (We shall presently refer to the prosecution in the Patent Office.)

The said 100,000 units (carton and lid) were sold in 1948 (Tr. 69).

In 1949, approximately 13,500,000 such units were sold (Tr. 69-70).

In the latter part of 1949, a subsidiary modification (within the scope of the patent application) came into being. It is illustrated in Plaintiff's Exhibit 19, a print of a shop drawing dated October 27, 1949, and the modification lay in enlarging the peripheral groove or recess at all four corners of the lid, the enlargement taking a triangular shape instead of rectangular as previously (Tr. 68-69).

Plaintiff's Exhibit 20 and Exhibit 21 illustrate the new type carton and lid; in the former, the top of the glue flap of the manufacturer's joint is cut away at a 45-degree angle, and, in the latter, the receiving enlargement of the peripheral recess is correspondingly made triangular, thus being closed at the apex whether or not filled by the carton wall double thickness; the point is to make it unnecessary for the housewife, in applying the lid to the carton, to register a particular corner of the lid with a particular corner of carton, the result being the same in any of the four positions of the lid relative to the carton (Tr. 71-73).

Container began selling this new type in 1950, and, in that year, whether arrow type or new type, sold 11,000,000 units; 1951, 12,500,000, all new type; 1952, 16,600,000; 1953, 15,100,000 (Tr. 70).

The patent issued May 12, 1953, and plaintiff began patent-marking the carton element (printing) with its first production for 1954 sales; the lid element when new molds were in order (Tr. 71-72).

Thus, the history of the conception, development, reduction to practice, commercialization, and public acceptance of the invention at bar.

It is appropriate, now, to consider briefly the application for the patent in suit, referring to Plaintiff's Exhibit 5 (Tr. 42-43), the file wrapper and contents of the patent in suit, and Plaintiff's Exhibit 6 (Tr. 43), copies of the prior patent references cited by the Patent Office Examiner in the course of the prosecution.

The application illustrates and describes one of the one hundred thousand cartons and lids sold in the early part of 1948, exemplified by Plaintiff's Exhibits 16 and 17, and Plaintiff's Exhibit 5 reflects a normal prosecution, directed to the determination of allowable claims in view of the prior art.

The amendments to the specification were purely formal.

Fourteen claims were initially presented (May 10, 1948). On January 24, 1949, all of those claims were rejected, by the Examiner, on five prior art references. In reply, in July, the applicant cancelled all fourteen claims, and presented Claims 15 to 20, inclusive.

In his next Action, July 27, 1950, the Examiner stated that Claims 18 and 20 appeared to be allowable; but he rejected Claims 15, 16, 17 and 19 on three further references, including one now relied upon by defendant.

(Claims 18 and 20 became Claims 1 and 2, respectively, of the issued patent.)

In reply (January, 1951), the applicant amended the four rejected claims, and added two new claims, 21 and 22.

On October 22, 1951, the Examiner rejected Claims 15, 16, 17 and 19, as amended, on three further references, including another now relied upon by defendant, but stated that the two new claims, 21 and 22, appeared to be allowable.

(Claims 21 and 22 became Claims 3 and 4, respectively, of the issued patent.)

FROZEN FOOD CARTON WITH PLASTIC LID

Filed May 9, 1948

Fig. 1.

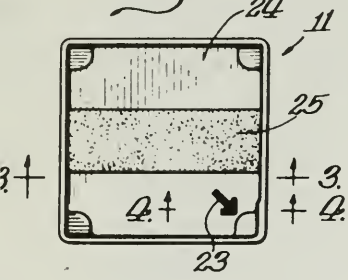


Fig. 3.

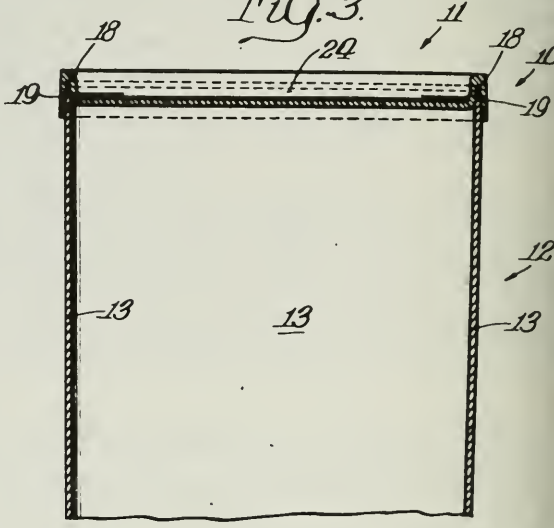


Fig. 2.

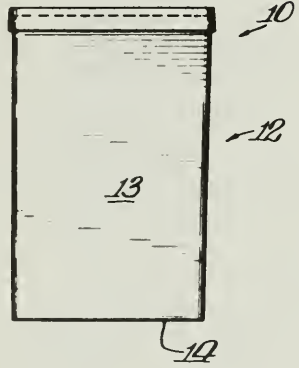


Fig. 4.

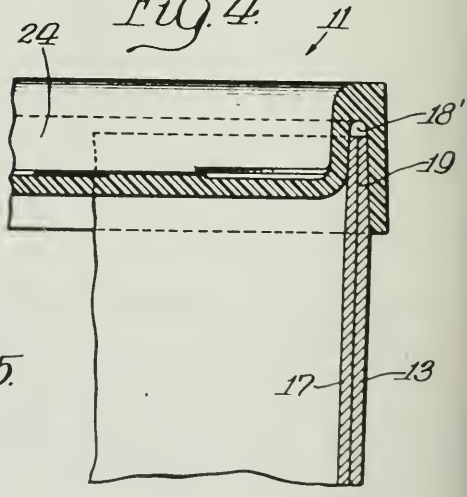
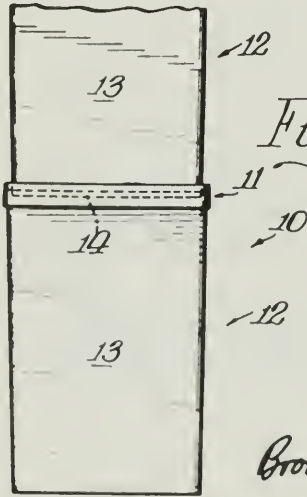


Fig. 5.



Inventor.
William J. Poole

By
Brown, Jackson, Boettcher & Diener
Attys

In reply (February, 1952), the applicant amended Claims 15, 16 and 17 further, cancelled Claim 19, and added two new claims, 23 and 24.

On September 19, 1952, the Examiner stated that the two new claims, 23 and 24 appeared to be allowable, but he rejected Claims 15, 16 and 17, as further amended, on the same references, making that rejection final.

Whereupon, the applicant filed an appeal to the Board of Appeals in respect of rejected Claims 15, 16 and 17, and, in due course, filed the brief required in such proceeding.

On November 24, 1952, the Examiner handed down his Statement on the appeal, and, in due course thereafter, the appeal was set for hearing on October 8, 1953.

In March 1953, the applicant, deciding to forego the three claims in question, gave notice to the Patent Office accordingly by filing a cancellation of them, which, on March 30, 1953, resulted in an allowance of the application with its Claims 18, 20, 21, 22, 23 and 24.

Due payment of the final Government fee resulted in issue of the patent (Plaintiff's Exhibit 3) on May 12, 1953, with said claims, respectively renumbered 1, 2, 3, 4, 5 and 6.

A copy of the patent drawing is inserted here for reference and it will be seen that the various figures show a carton like Plaintiff's Exhibit 16 and a lid like Plaintiff's Exhibit 17 which is one of the first samples off the production mold from which the 100,000 run was made in the early spring of 1948 (see page 6, *supra*). (Referring to the circular markings at the four corners of Fig. 1, not referred to in the specification, they are the marks left by the sprues through which the fluid material is flowed into the mold.)

Consistently with the facts related by Mr. Poole, the patent points out the attributes of the carton *per se*—its construction from a single waxed paper-board blank with sidewall glue flap, its full-open top, its rectangular form, and its slight taper for nesting.

(The slight taper of the carton *per se* is not recited in any of the claims of the patent and is not involved against the accused assembly.)

Also, as in Mr. Poole's account, the patent points out the attributes of the lid,—its form with the under-side peripheral recess to receive and match the upper margin of the carton, the upward taper of its peripheral recess and the wedging action upon downward pressure, and the material of which it is made.

(Stacking of filled packages, as illustrated in Figure 5, is also made point of, but that entails slight taper of the carton *per se*, which, as above stated, is not involved here.)

As to the claims:

There are six claims. Claims 1 and 3 go to the combination of carton and lid, and Claims 2, 4, 5 and 6 go to the lid *per se*.

To exemplify the reading of the claims on the patent disclosure, we apply the first of each of these groups to the patent drawing by reference characters, as follows:

Claim 1:

A frozen food carton comprising, an open top paper-board body (12) having a lengthwise lap joint (17, Fig. 4) extending to its upper edge (19), and a plastic friction cover (11) having a downwardly opening peripheral recess (18, Fig. 3) tapering upwardly, said recess being of increased width (18', Fig. 4) for a portion of its length corresponding to said lap joint and of uniform width for the remainder of its length and

fitting tightly over the upper edge portion of the wall (13) of said body with the opposed surfaces of said recess contacting the inner and the outer surfaces of said wall for the major portion of the depth of said recess and compressing said wall between said opposed surfaces thereby providing a tight friction seal between said cover and said body.

Claim 2:

A reusable plastic cover (11) for a frozen food carton body having a lengthwise lap joint extending to its upper edge, said cover having a downwardly opening peripheral recess (18, Fig. 3) tapering upwardly, said recess being of increased width (18', Fig. 4) for a portion of its length corresponding to the lap joint of the carton body and of uniform width for the remainder of its length, for frictional engagement over the upper edge portion of the wall of the carton body.

Claim 3, the other claim to the combination of carton and lid, is like Claim 1, except that it requires the open-top paper-board body to be substantially rectangular in cross-section and the lap joint to be at a corner, and the lid to be correspondingly rectangular and to have the widened portion of its peripheral recess at a corner.

Claim 4, a lid claim, differs from Claim 2, in effect, as Claim 3 differs from Claim 1, *i. e.*, the lid is required to be substantially rectangular and to have the widened portion of its peripheral recess at a corner.

All first four claims require the lid to be of a plastic. Claim 5 is not restricted in that respect; in effect, it is like Claim 4, not limited in that respect, but, specifically directed to the rounded corners (see Fig. 1), which facilitate application to the carton.

Claim 6 is like Claim 4, except that it is not limited to a thin-walled peripherally-flanged construction, but would embrace a prismatic form.

All the units sold by plaintiff in 1948 and 1949 and into 1950 were, in all material respects, identical with the carton and lid assembly illustrated and described in the patent, and thus under all the claims of the patent.

Plaintiff's modified type, with the chamfered upper end of the carton glue-flap and the triangular enlargement of the peripheral recess at all four corners, represented by Plaintiff's Exhibits 20 and 21, which came into being in the latter part of 1949 and into vogue in 1950, come under at least Claims 3, 4, 5 and 6 of the patent.

The Infringement by Defendant.

Plaintiff's cause of action lies in defendant's manufacture and sale of plastic lids identified, under "No. 1", in Plaintiff's requests for Admissions of Fact (Pl. Ex. 7, Tr. 16-17), which defendant did not answer and which, therefore, under the Rule, stand as admissions of fact (Tr. 43-44). The specimens are in evidence as Plaintiff's Exhibits 8 and 9 (Tr. 44).

Defendant's enterprise, here complained of, conducted under the adopted names "Ree-Seal" and "ReeSeal Company" (Pl. Ex. 7, No. 4, Tr. 18), was obviously born of the idea of selling lids like plaintiff's for use with used waxed paper-board milk containers which the housewife would ordinarily discard. This is evidenced by defendant's literature, Plaintiff's Exhibits 10 and 11 and defendant's advertisement in *Locker Management* for January, 1953, Plaintiff's Exhibit 12 (Tr. 44-45), all identified by Plaintiff's Exhibit 7, No. 2 and No. 3 (Tr. 17-18).

Defendant began the manufacture and sale of the accused lids in March of 1951 (Defendant's Answers, Pl. Ex. 15, to Plaintiff's Interrogatories 4 and 7, Pl. Ex. 14, see Tr. 23); but they did not come to the attention of plaintiff until shortly before November 2, 1953, when plaintiff sent

(Reference characters added.) / FIG. 4.

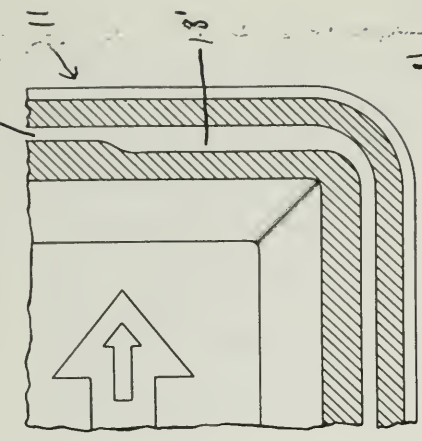
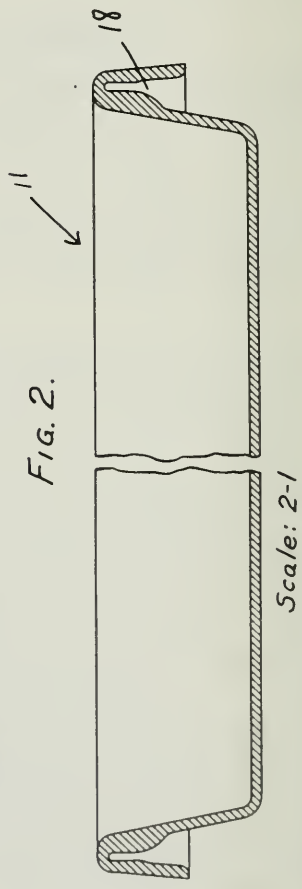
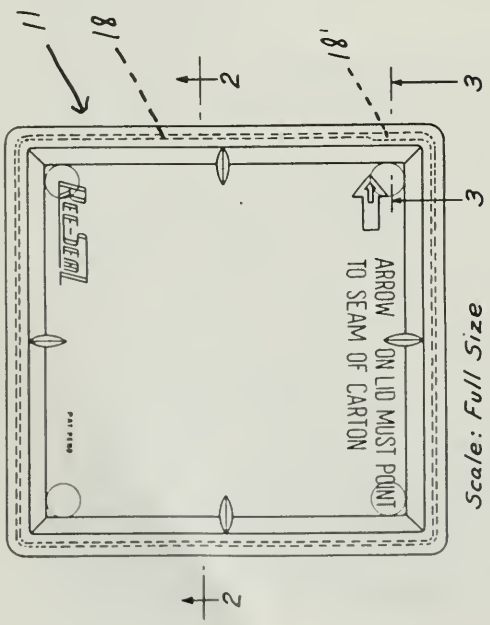


FIG. 1.

a letter to Ree-Seal (Pl. Ex. 13, Tr. 45), giving notice of infringement of the patent in suit, said letter having been received by defendant on or about November 5, 1953 (Pl. Ex. 7, No. 5, Tr. 18).

Defendant's lids are of two sizes, one to fit the horizontal cross-section of the half-gallon carton (top portion cut off), exemplified by Plaintiff's Exhibit 22B, and the other to fit the horizontal cross-section of the quart carton (top portion cut off).

Inserted here is a copy of Plaintiff's Exhibit 22A (See Tr. 122-123), which is a drawing of defendant's lid, Plaintiff's Exhibit 8. In the original, Fig. 1 is full size, but here the entire drawing is reduced to fit into this brief; the scales in the various figures are indicated.

That the structure is the same in all material respects as that of the lid of the patent in suit is self-evident.

The carton for which it is intended, Plaintiff's Exhibit 22B (Tr. 121) is the same as the carton of the patent, except for the slight taper of the latter which is optional in the patent claims.

The procedure instructed by defendant is set forth in its literature (Pl. Ex. 10, Tr. 17-18, 44-45—copy inserted here), Steps 1 and 2 of which set forth the initial preparation of the carton *per se* by cutting off the top portion of the milk carton; Step 3 is the rinsing of the carton and then allowing time to resume its condition as a waxed paper-board container (body minus top). Step 4 illustrates and describes the simple application of the lid to the carton, uniformly throughout assuming the widened portion of the peripheral recess to be aligned with the manufacturer's joint.

SAVE YOUR USED

- MILK CARTONS —
- THEY'RE VALUABLE

REES-SEAL
LET THEM MAKE REE

THE NEW VACUUM TIGHT LID — FITS ALL STANDARD HALF GALLON MILK CARTONS, MAKES THEM PERFECT FOR STORING OR DEEP FREEZING ALL FOODS AND LIQUIDS.

REES-SEAL
LET THEM MAKE REE

AIR-TIGHT, WATER-TIGHT

Pat. Pending



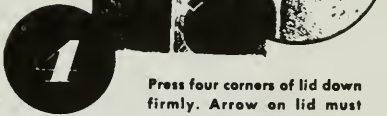
1

Cut through 3 sides of carton scoring 4th side.



2

Turn carton over and cut scored side.



1

Press four corners of lid down firmly. Arrow on lid must point to seam on carton.



5

Store FROZEN FOODS in Freezer
Store DRIED FOODS in kitchen cabinets
Store LEFT OVER FOODS in refrigerator



6

Remove lid by raising one corner at a time.

Manufactured by THE REE-SEAL COMPANY
12050 VENTURA BLVD. LOS ANGELES, CALIF.



3

Rinse carton in cool water. Allow carton to dry thoroughly before using.

CUT AT LEAST ONE INCH BELOW BOTTOM OF POUR- SPOUT TAB.

Step 5 shows the storing of the packages in the freezer,—on their sides in this instance. Step 6 illustrates the opening of the package.

As we have above applied Claims 1 and 2 to the drawing of the patent in suit, we apply them here to this drawing of defendant's lid, using the same reference characters:

Claim 1:

A frozen food carton comprising, an open top paperboard body having a lengthwise lap joint extending to its upper edge and a plastic friction cover (11) having a downwardly opening peripheral recess (18) tapering upwardly, said recess being of increased width (18') for a portion of its length corresponding to said lap joint and of uniform width for the remainder of its length and fitting tightly over the upper edge portion of the wall of said body with the opposed surfaces of said recess contacting the inner and the outer surfaces of said wall for the major portion of the depth of said recess and compressing said wall between said opposed surfaces thereby providing a tight friction seal between said cover and said body.

Claim 2:

A reusable plastic cover (11) for a frozen food carton body having a lengthwise lap joint extending to its upper edge, said cover having a downwardly opening peripheral recess (18, Fig. 3) tapering upwardly, said recess being of increased width (18', Fig. 4) for a portion of its length corresponding to the lap joint of the carton body and of uniform width for the remainder of its length, for frictional engagement over the upper edge portion of the wall of the carton body.

As to Claims 3, 4, 5 and 6, the analysis on Pages 11 and 12, *supra*, show that they, too, apply to defendant's half-gallon lids and their intended cooperation with the half-gallon carton.

As to the quart size lid, Plaintiff's Exhibit 9, which is

adapted to the quart milk carton exemplified by Plaintiff's Exhibit 23A :

Here the carton structure (Pl. Ex. 23A) is somewhat different from the half-gallon size in that the lap-joint is in the middle of a side wall instead of at a corner, but the fundamental structure and the procedure is the same, as evidenced by Plaintiff's Exhibit 9 itself and defendant's literature, Plaintiff's Exhibit 11.

Since the enlargement of the peripheral recess in the lid, Plaintiff's Exhibit 9, is in the middle of a side wall instead of at a corner, and since Claims 3, 4, 5 and 6 require the lap-joint of the carton and/or the enlargement of the peripheral recess in the lid to be at a corner, they do not apply, but Claims 1 and 2 are not so limited and clearly apply as above pointed out in respect of the half-gallon size lid, Plaintiff's Exhibit 8.

Although defendant manufactures and sells only the lids, it is liable not only under the lid *per se* claims of the patent, but is equally liable under the carton and lid combination claims, this under Section 271(b) and (c) of United States Code, Title 35.

The Question Involved and the Manner in Which It Is Raised.

Defendant, in its Answer, denied infringement, but it did not, at any time, adduce anything in support of that denial. In its brief below, on final hearing (Closing Brief for Defendant, listed in Certificate of Clerk, Tr. 37), defendant stated that there were "two primary issues", explaining that there can be no infringement of an invalid patent. That goes without saying, but it is not what is commonly understood by an issue of infringement; an issue of infringement is one of non-infringement, assuming the patent in suit to be valid in accordance with the presumption of law.

The issue here is validity of the patent.

There is no anticipation, nor any asserted; the subject matter of the patent stands as new.

The question involved is whether its creation constituted an act of invention, or were the differences between it and the prior art "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains" (Title 35, United States Code, Section 103).

That that is the single question involved is made clear by the Decision of the Court below (Tr. 26-28), which we shall refer to in the Argument to follow.

Now, as to the manner in which the question is raised:

Defendant adduced the following:

(1) Defendant's Exhibit B, containing copies of seven patents of which, as previously stated, defendant notified plaintiff under Title 35, United States Code, Sec. 282 (2);

(2) Defendant's Exhibit A, the file history of the Van Saun Patent No. 2,392,959, included in Defendant's Exhibit B.

(3) Defendant's Exhibit C and D, two argumentative sketches (Tr. 79-80).

(4) The adverse testimony of Mr. Poole, the inventor.

(5) The testimony of Mr. Robert C. Comstock, called by defendant as its expert.

(6) Defendant's Exhibit H, the File Wrapper and contents of the Hill Patent 2,623,685, included in Defendant's Exhibit B; and

(7) Defendant's Exhibit I, a certified copy of said Hill Patent 2,623,685, included in Defendant's Exhibit B.

The purpose of all this was to leave it that, when Mr. Poole essayed to produce a new package for a particular

use, and did so, he did none other than anyone of ordinary skill in the art would naturally have done at the time.

We treat this subject in the Argument to follow.

SPECIFICATION OF ERRORS RELIED UPON.

In this brief, we proceed from the Statement of Points, filed in the District Court (Tr. 33-34), and adopted in this Court (Tr. 195), as follows:

1. The District Court, weighing the subject matter of the patent in suit for invention, erred in taking into account only the lap joint of the open-top carton and the widening of the under-side peripheral recess of the cover to accommodate the double thickness of the lap.

2. The District Court, weighing the subject matter of the patent in suit for invention, erred in not taking into account all the recitations in each of the claims of the patent in suit.

3. The District Court, weighing the subject matter of the patent in suit for invention, erred in not treating the same as a patentable combination of the elements as specified in the claims.

4. The District Court erred in finding the structure of the patent in suit wanting in invention and in finding that producing it involved no more than ordinary skill of the art.

5. The District Court erred in holding the patent in suit invalid and void, in dismissing the complaint, in sustaining defendant's counterclaim, and in awarding costs to defendant.

6. The District Court erred in not holding the patent in suit valid and infringed, in not granting the relief prayed for in the complaint, and in not dismissing the counterclaim, with costs to plaintiff.

ARGUMENT.

We first concern ourselves with Points 1, 2 and 3, which we repeat:

1. The District Court, weighing the subject matter of the patent in suit for invention, erred in taking into account only the lap joint of the open-top carton and the widening of the under-side peripheral recess of the cover to accommodate the double thickness of the lap.

2. The District Court, weighing the subject matter of the patent in suit for invention, erred in not taking into account all the recitations in each of the claims of the patent in suit.

3. The District Court, weighing the subject matter of the patent in suit for invention, erred in not treating the same as a patentable combination of the elements as specified in the claims.

It is clear, from the Notice of Decision (Tr. 26-28), that the Court below considered only the last step of the development of the package at bar, *i. e.*, the widening of the under-side groove of the cover to accommodate the lap joint of the paper-board carton, as the measure of "invention", and we respectfully submit that it erred fundamentally in that regard.

It is not the fact that the patented package was of the prior art except for the accommodation of the cover to a carton with a lap joint, yet it appears that the Court below so regarded it, which leads us to believe that the Court below gave weight to the Hill Patent 2,623,685 (last patent in Defendant's Exhibit B) to which it was not entitled under the law.

That Hill patent illustrates and describes a square paper-board carton (not lap joint) and a square plastic cover with an underside groove to receive the upper margin of

the carton. The feature of the patent is to make the skirt of the cover flexible to facilitate prying it off.

If that patent were prior art against the Poole patent in suit, Mr. Poole's contribution would be limited to the stiffening of the skirt and the widening of the underside groove to accommodate a lap-joint of the carton. There is no evidence here of utility and public acceptance of the Hill structure, against that of the Poole structure, but question of patentable measure of Poole over Hill need not be debated here because Hill is not prior art, under the law, and Poole's patent claims go to complete combinations which Hill does not and can not claim.

Defendant's Exhibit B, containing the Hill patent, was offered entitled "Prior Art Patents"; it was not objected to on the ground that the patent copies were not certified copies, but was objected to on the ground that it contained this Hill patent and that this Hill patent was not a "Prior Art" patent. Upon deletion of the words "Prior Art" from the title the exhibit was received (Tr. 65-67).

Plaintiff's point was and is that, although the application for the Hill patent was filed October 3, 1947, it did not go to issue until 1952, and therefore was not "prior art" against the Poole application for the patent in suit, which was filed on May 10, 1948.

This point was argued at some length at the trial (Tr. 127-135), but it was left for decision on final hearing (see also Tr. 189-190).

Let us make it clear that the objection to the Hill patent lies in its submission *as prior art* from which to measure the inventive quality of the subject matter of the patent in suit.

Defendant contended that the Hill patent is such prior art as to the patent in suit. We respectfully submit that, in so doing, defendant is mistaken as to the law.

The prior art, from which the inventive quality of something new is to be measured, is not to be confused with anticipation, which means *the same invention* earlier by someone else.

There are two "conditions for patentability" sections in the patent statutes, United States Code, Title 35.

Section 102 prescribes the fundamental requirement of novelty, *i. e.*, there must be no anticipation of the subject invention.

Section 103 has to do with patentable quality, *i. e.*, whether or not the thing found to be new over *the prior art* amounts to an invention.

"The prior art" is public knowledge at a given time, from which the inventor departs. That is abundantly clear from the body of law which has been long in the making.

When the Patent Office Examiner considers a patent application, he cites the prior art which he finds pertinent; but he does not take any co-pending patent application into account unless it discloses the same invention.

The Hill invention is not the Poole invention; it lies simply in the flexibility of the skirt 15 of its plastic cover to facilitate prying-off, which Poole did not disclose. Poole, on his disclosure, could not make the single claim of Hill's patent, nor could Hill, on his disclosure, make any claim of Poole's patent; had there been a common invention, interference proceedings would have been in order.

Incidentally, so far as this case is concerned, the filing date of the application for the Hill patent is October 3, 1947, and Mr. Poole had disclosed *his* invention to the personnel of the Crown Cork Specialty Corporation, of which Mr. Hill was president (Tr. 140), prior to that (Tr. 60-65). It is a reasonable deduction that Mr. Hill, learning of Mr. Poole's work, formulated an idea of his own about plastic lids for square full open top paper-board

cartons, and, with entire propriety, proceeded to patent it. Mr. Poole's testimony was not adduced to ante-date Mr. Hill's filing date; there was no occasion for that; it was adduced to relate to the Court the process of the making of the invention at bar—the steps, including the objective to serve a certain purpose, the selections of carton and cover material, the cover construction, the trial-and-error, and its ultimate reduction to practice precisely as shown in the patent drawing, its acceptance by the purchasing public.

Though Mr. Hill's application for patent was filed before Mr. Poole's, it did not become public until long after Poole filed.

It would be strange indeed if an inventor should, under the law, be charged with the burden of exhibiting patentable quality over something concealed against him and the public at the time of his creative act.

And such is not the law.

In *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, 159 F. (2d) 379 (C. C. A. 2nd), the Court said at page 381:

“Foster filed his application over twenty months before Lewis and Menihan filed theirs, but his patent did not issue until after they had filed, and his disclosure was therefore not prior art; if it is to invalidate their claims it must be because he was the ‘prior inventor’.”

In re Spencer, 47 F. (2d) 806, the Court of Customs and Patent Appeals said at page 807:

“The application of the appellant having been filed prior to the issuance of the Schwimmer patent, said patent cannot be cited here as a reference showing the prior art. *Bates v. Coe*, 98 U. S. 31, 25 L. Ed. 68; *Gray Tel. Pay Station v. Baird Mfg. Co.* (C. C. A.), 174 F. 417; *Johns-Pratt Co. v. E. H. Freeman Electric Co.* (D. C.), 201 F. 356, affirmed in *E. H. Freeman*

Electric Co. v. Johns-Pratt Co. (C. C. A.), 204 F. 288. We shall therefore disregard this reference in considering the matter.”

In *Gray Telephone Pay Station Co. v. Baird Mfg. Co.*, 174 F. 417 (C. C. A. 7th), the Court said at page 421:

“Defendant cites Gentry patent, No. 516,433, granted March 13, 1894, for a telephone toll station and Alexander patent, No. 544,077, granted August 6, 1895, for improvement in coin-signal apparatus for telephone pay stations. The application for the patent in suit was filed November 17, 1893. It thus appears that at the time the application for the patent in suit was filed these two alleged anticipating patents were not in the prior art, and cannot be availed of as anticipations. *Bates v. Coe*, 98 U. S. 31, 25 L. Ed. 68; *Anderson v. Collins*, 122 Fed. 451, 58 C. C. A. 669; *Eck v. Kutz*, 132 Fed. 758; Walker on Patents, § 70; Robinson on Patents, § 331, and note, 332, 334; *Barnes v. Sprinkler Co.*, 60 Fed. 605, 9 C. C. A. 154.”

In *American Graphophone Co. v. Emerson Phonograph Co.*, 255 F. 574 (D. C. S. D. New York), the Court said at page 578:

“Defendants offered in evidence the Clark and Johnson patent, No. 624,625, granted May 9, 1899, but applied for prior to the date of the Jones application. This is not prior art in this case. *Autosales Gum & Choc. Co. v. Ryede* (D. C.), 138 C. C. A. 648, 222 Fed. 956, affirmed 223 Fed. 1021, and cases cited.”

Since the Hill patent is neither for the same invention as Mr. Poole's, and since under the law it is not prior art against which to measure invention by Mr. Poole under the statute, it has no pertinency in this case.

Although quoting this Court (Tr. 27) in *New York Scaffolding Co. v. Whitney*, 224 F. 452, on patentability of a new and useful combination of old elements, the Court below, after pointing out that there must still be “invention” as distinguished from mere mechanical skill, states:

“The Court is convinced that any reasonably competent person skilled in the art, if presented with the problem of providing a cover for a lap-jointed carton, could have produced what Poole produced and, in so doing, would not have gone beyond the simple skills known and practiced in the art.”

That is a factor, to be sure, but the subject matter of the patent in suit is considerably more than that, as will be clear from the patent, its file history (Pl. Ex. 5), and the testimony of Mr. Poole, who assumed the stand as a fact witness to the features of the ultimate package for its intended purpose, which features are variously recited in the patent claims.

The carton is lap joint for economical manufacture, it is open top for facilitating filling and, more important, the removal of the contents, and is rectangular for compact storage; the cover must therefore also be rectangular, which means that it is incapable of twisting application to the container body, like the cover of a pill-box or baking powder can; it must be applicable by simple downward hand pressure. The cover is a one-piece plastic molding for economical manufacture, low co-efficient of expansion and contraction, and for re-use, its under-side peripheral recess tapered upwardly for tight frictional engagement with the carton wall margins by such simple downward hand pressure; and the enlargement of the underside recess to receive the lap joint of the carton insures uniformity on the downward hand pressure and avoids breaking. The file history shows that all of the above characteristics were taken into account in the allowance of the claims of the patent.

All the claims, like the claims of most patents are combination claims. Even Claims 2, 4, 5 and 6, which are for the lid only, are combination claims; they combine a plurality of elements which individually may be old, the nature of the carton body for which it is adapted being

stated or implied; Claims 1 and 3 include the carton body as an element.

We respectfully submit that all the claims of the patent are true combination claims, the elements cooperating to the end of a new and useful package.

This Court has contributed extensively to the body of law in this regard, and we simply submit our interpretation of the facts as established by the evidence.

It is now in order to consider the prior art contained in Defendant's Exhibit B, and the testimony of Mr. Comstock, defendant's expert, with reference thereto. Mr. Comstock, the only witness called on behalf of defendant, is a member of the Bar and an experienced patent practitioner, and his testimony leaves us with no course but to assume that we are as able as he to understand the patent in suit, to gauge its scope, and to compare or contrast its substance with that of the prior art.

The art has no depths which necessitate a technical expert; the facts can readily be understood by Court and counsel. Plaintiff produced no expert, so-called; Mr. Poole was an experiential witness; he testified on facts, no opinions.

Of the six patents, other than Hill (Hill is not prior art), in Defendant's Exhibit B, Drake 1,325,930 and Kurz 1,969,496 were references in the Patent Office in the Poole application and were disposed of there.

The Drake Patent is for the combination of a circular molded pulp fiber receptacle, having an unfinished or raw edge at its open end, and a circular cap of thin somewhat-yielding metal formed with a flared underside groove to receive such edge, the purpose being to force the two elements, we assume naturally by a downward twisting motion, to conform to each other.

The Kurz Patent shows a plastic beverage shaker, the body being of the tumbler type and the cover being circular dome-shape, fitting into the margin of the body.

It is understandable why these references were disposed of in the Patent Office.

It is also understandable why the other prior art patents in Defendant's Exhibit B were not cited by the Patent Office Examiner.

The Rutkowski Patent 2,155,022 shows a tubular wound-paper body with a circular metal bottom and a two-part circular metal cover forming a circular under-side groove to receive the margin of the body, one form (Fig. 7) showing the groove flared for wedging action. There is no lap-joint and the cover is presumably factory-applied, and, if by hand, by twisting manipulation.

The Moore Patent 2,381,508 is for a build-up shipping container. The body (called the shell) is rectangular and has a lap joint, and the top and bottom comprise *partially formed members which are built to the body in the process of completing the package*; neither is a completed unit like Mr. Poole's lid. They are partially formed blanks with uniform end flanges providing the beginnings of a groove, and a wooden block to fit in the depression formed by the flanges; and, in final closing of the container with its contents, the flanges are nailed through the body wall to the block, regardless of whether the wall, at that point, is of one thickness or two (see Figure 3).

The Van Saun Patent 2,392,959 (incidentally, a patent of plaintiff) is for a paperboard drum for waxes, asphalt, resins and like materials, which are packaged in hot liquid condition and then allowed to solidify in the drum. It has a circular body with a lap-joint, and has a circular top and bottom, like the cover of a pill box, stapled to the body on packing. It is for heavy use, and the top and bottom are

strengthened by an auxiliary disc which defendant asserted below to define an annular recess corresponding to the peripheral recess of the patent in suit; a far-fetched assertion, since the recess referred to has a depth of only the paper-board thickness of the disc, and a width greater than the body wall thickness, even where the body wall is double (lap-joint); there is no intention or desire for a tight friction fit and no peripheral groove of the character and function of the peripheral groove of the patent in suit.

In addition to the copy of the Van Saun patent in Defendant's Exhibit B, defendant offered, as its Exhibit A, a certified copy of the file wrapper and contents of that patent, and plaintiff objected to it as immaterial (Tr. 74); see colloquy, Tr. 74-78, 82-86, 168-169). The Court received the exhibit, subject to argument on final hearing; the subject was briefed but there was no specific ruling thereon thereafter. It is still plaintiff's position that the exhibit is immaterial.

The patent itself issued on January 15, 1946 and is definitely of the prior art with reference to the Poole invention, having issued more than one year prior to the filing of the Poole application (May 10, 1948). Whatever the Van Saun structure, it is spelled entirely by the patent itself, and the file history can neither add to nor detract from it.

So far as the merits of the case are concerned, it is immaterial to plaintiff whether the Van Saun file history is in or out, but there is no point in encumbering the evidence with it or burdening the Court about it.

The Van Saun drum utterly fails to meet the subject matter of the Poole patent in suit, as above pointed out, and the Poole subject matter is patentable over it.

The Merkle Patent 2,399,241 shows a rectangular container with a lap joint, but is of no consequence here because the cover is permanently secured and sealed to the

body by an adhesive and by heat and pressure, except for the pouring lip, to which the patent is directed and which is closed and sealed after filling. It is not a friction cover, and has no concern over the lap joint.

Defendant's Exhibits C and D, as previously pointed out, are merely argumentative sketches, obviously intended to measure the patent in suit by the widened portions of the under-side groove in the cover. As we have pointed out, that is an item in the patented structure, but the claimed combinations must be taken as a whole.

As to the testimony of Mr. Comstock, the direct examination is simply the presentation of an argument by dialogue, (1) treatment of the patents contained in Defendant's Exhibit B, (2) coupling of references to meet the claims of the patent in suit; and (3) assertion of no invention in the patent in suit:

(1)

This is a matter of the facts, and we think we have made the necessary refutations above.

(2)

The law frowns upon the invalidating of patent claims by the *ex post facto* manufacture of a "reference" from a plurality of independent sources.

In *Bates v. Coe*, 98 U. S. 31, the Supreme Court said, at page 48:

"Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any

greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement.”

In *Parks v. Booth*, 102 U. S. 96, the Supreme Court said, at page 103:

“Most or all of the inventions described in those publications bear more or less resemblance to that claimed by the complainant, and it may be that if it were allowable to test the validity of the invention in question by comparing the same with the whole as if embodied in a single exhibit, the evidence might be sufficient to support the views of the respondents in respect to the defence under consideration. Were that allowable it might well be suggested that the screen is found in one, the box in another, and the means to produce the lateral shake in a third, and so on to the end; but it would still be true that neither the same combination in its entirety nor the same mode of operation is described in any one of the patents or printed publications given in evidence.”

In *Ry-Lock Company v. Sears, Roebuck & Co.*, 227 F. (2) 615 (1955), the Court of Appeals for the Ninth Circuit said, at page 618:

“Hence, a finding which, as here, picks out one element in one prior patent and another element in another prior patent as a demonstration of anticipation, is manifestly insufficient to overcome the presumption arising from the issuance of the patent, a presumption reemphasized by the existing Act.”

In *Williams Mfg. Co. v. United Shoe Mach. Corp.*, 121 F. (2d) 273, the Court of Appeals for the Sixth Circuit said, at page 278:

“* * * It is not to be struck down by the familiar expedient of picking out old elements of the prior art and speculatively combining them when in practice they have never been combined, though the need for a machine of the type disclosed had long been recog-

nized. The claims of McFeely in suit are valid and infringed.”

In *Stebler v. Riverside Heights Orange Growers' Ass'n.*, 205 F. 735, the Court of Appeals for the Ninth Circuit said, at page 738:

“True, we may pick out one similarity in one of these devices, and one in another, and still one in another, and, by combining them all, anticipate the inventive idea expressed in the Strain patent, but the combination constituting the invention is not found in any one of them. As we had occasion to say in *Los Alamitos Sugar Co. v. Carroll*, 173 Fed. 280, 97 C. C. A. 446:

‘It is not sufficient to constitute an anticipation, that the devices relied upon might, by a process of modification, reorganization, or combination, be made to accomplish the function performed by the device of the patent.’ *Western Electric Co. v. Home Tel. Co.* (C. C.), 85 Fed. 649; *Topliff v. Topliff*, 145 U. S. 156, 12 Sup. Ct. 825, 36 L. Ed. 658; *Gunn v. Bridgeport Brass Co.* (C. C.), 148 Fed. 239; *Ryan v. Newark Co.* (C. C.), 96 Fed. 100; *Simonds R. M. Co. v. Hathorn Mfg. Co.* (C. C.), 90 Fed. 201-208; *Gormully & J. Co. v. Stanley Cycle Co.* (C. C.), 90 Fed. 279; *Merrow v. Shoemaker* (C. C.), 59 Fed. 120.’ ”

In *Robertson Rock Bit Co. v. Hughes Tool Co.*, 176 F. (2d) 783 (C. C. A. 5th), the Court said, at page 789:

“It will not do, as appellant tries to do, to cull from one and another of the prior patents elements of the combinations in suit. They must show not that some of the elements are present in the prior patents but that the combination is. The evidence as a whole is not sufficient to overcome the presumption attending their granting.”

(3)

This comes under the fourth specification of errors, which we repeat:

4. The District Court erred in finding the structure of the patent in suit wanting in invention and in finding that producing it involved no more than ordinary skill of the art.

The defense of "no invention" is always resorted to when a definitive defense is not at hand or fails. Hence, it presents a question pondered by the Courts ever since the beginning of the patent system. Every case on this issue is a case of its own; it depends upon the evidence and how the facts impress the Chancellors. As Mr. Justice Brown said in *McClain v. Ortmyer*, 141 U. S. 419, at pages 426-427:

"To say that the act of invention is the production of something new and useful does not solve the difficulty of giving an accurate definition, since the question of what is new as distinguished from that which is a colorable variation of what is old, is usually the very question in issue. To say that it involves an operation of the intellect, is a product of intuition, of something akin to genius, as distinguished from mere mechanical skill, draws one somewhat nearer to an appreciation of the true distinction, but it does not adequately express the idea. The truth is the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have by a process of exclusion determined that certain variations in old devices do or do not involve invention; but whether the variation relied

upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition."

No personnel of defendant appeared at the trial. The story of its activities was adduced entirely by plaintiff. We do not know if its accused lids were copied from plaintiff's lids (by 1950, millions of plaintiff's lids as illustrated in the Poole patent had gone out to the public), or were independently inspired (as might be inferred from the fact that the accused lids are marked "PAT. PEND.>").

In either case, its contention that the patent in suit is invalid for lack of invention is to be materially discounted.

The statement of Judge Hough, in *Kurtz et al. v. Bell Hat Lining Co., Inc.*, 280 Fed. Rep. 277, 281 (C. C. A. 2nd), has been frequently quoted in the decisions:

"The imitation of a thing patented by a defendant, who denies invention, has often been regarded, perhaps especially in this circuit, as conclusive evidence of what the defendant thinks of the patent and persuasive of what the rest of the world ought to think."

In *Steiner Sales Co. v. Schwartz Sales Co.*, 98 F. (2d) 999 (C. C. A., 10th), the Court said, p. 1005:

"The fact that the Steiner cabinets have enjoyed marked commercial success and that Schwartz has endeavored to share therein by appropriating the teachings of patents 1,426,121 and reissue 17,352 lends strong support to our conclusion that the conception of these devices constitutes patentable invention."

In *H. D. Smith & Co. v. Peck, Stow & Wilcox Co.*, 262 Fed. Rep. 415, the Court said, p. 417:

"This willingness of the purchasing public to pay is a practical demonstration of its substantial value. The appellant's conduct in copying the structure and shape of the appellee's structure is a strong indication that

it, too, appreciates the value of this advance in the art. We conclude that the combination constitutes invention, and that the patent is valid.”

From *Ric-Wil Co. v. E. B. Kaiser Co.*, 179 F. (2d) 401 C. of A., 7th, 1950), p. 404:

“Defendant’s imitation of the patent structure is another indication of invention, *Kurtz et al. v. Bell Hat Lining Co., Inc.*, 2 Cir., 280 F. 277, 281; *Fones v. American Specialty Co.*, D. C., 38 F. 2d 639, 642; *Gairing Tool Co. v. Eclipse Interchangeable Counterbore Co.*, 6 Cir., 48 F. 2d 73, 75; *Sandy MacGregor Co. et al. v. Vaco Grip Co.*, 6 Cir., 2 F. 2d 655, 656.”

In *Town et al. v. Willis*, 85 F. Supp. 483 (D. C. W. D., Mo., 1949), the Court said, p. 487:

“It would seem that defendant’s position in denying that the device is patentable is further weakened by the fact that he filed an application for a patent on his own device—the accused device—which is practically identical in shape, material and construction, and which performs the same function in the same manner.”

On the appeal, 182 Fed. 2nd 892, the Court of Appeals 8th) said (p. 895):

“Taking into consideration the presumption of validity which attends the grant of the patent, the age of the problem upon which Town was working, the reception which the patented device received from the public as evidenced by its commercial success, the conceded need for some such device, the inferences which reasonably may be drawn from the fact that the defendant imitated the device, *Charles Peckat Mfg. Co. v. Jacobs*, *supra*, page 801 of 178 F. 2d, and that he obviously regarded such a device as patentable (as is indicated by his application for a patent on the accused device, filed in December, 1944), we think that the findings of the District Court that the patent in suit was valid and that Claim 1 was infringed, were not clearly erroneous.”

We quote from the above cases only because facts in them are so closely akin to facts here.

Conclusion.

Here, we quote again the remaining two specifications of errors:

5. The District Court erred in holding the patent in suit invalid and void, in dismissing the complaint, in sustaining defendant's counterclaim, and in awarding costs to defendant.

6. The District Court erred in not holding the patent in suit valid and infringed, in not granting the relief prayed for in the complaint, and in not dismissing the counterclaim, with costs to plaintiff.

The judgment of the Court below should be reversed, and plaintiff granted the relief prayed in its complaint.

Respectfully submitted,

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